

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Stieger et al.
Appl. No.: 10/538,583
Conf. No.: 9052
Filed: June 15, 2005
Title: NOZZLE ADAPTABLE TO STEAM OUTLET OF A COFFEE MACHINE
Art Unit: 3752
Examiner: James S. Hogan
Docket No.: 3712036-00625

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated August 5, 2010 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit that the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated November 16, 2009 as noted in Appellants' Appeal Brief filed on April 8, 2010, for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 1 and 3-12 be reversed.

II. THE REJECTION OF CLAIMS 1 AND 3-12 UNDER 35 U.S.C. §103(a) SHOULD BE REVERSED BECAUSE, EVEN IF THE EXAMINER ESTABLISHED A PRIMA FACIE CASE OF OBVIOUSNESS, APPELLANTS HAVE REBUTTED THE PRIMA FACIE CASE OF OBVIOUSNESS

Appellants respectfully request that the Board reverse the rejections of Claims 1 and 3-12 under 35 U.S.C. §103(a) because the Examiner has still failed to establish a *prima facie* case of obviousness with respect to the cited references. Appellants respectfully submit that the cited references fail to disclose or suggest each and every element of the present claims and that, even if the Examiner establishes a *prima facie* case of obviousness, Appellants have rebutted the *prima facie* case of obviousness.

In the Examiner's Answer, the Examiner fails to respond to Appellants arguments that *Probst* and *Cicchetti* fail to disclose or suggest each and every element of the present claims. Instead, the Examiner asserts that "[t]he notation of the Examiner's use of the term 'mostly' one-piece is used to show that where *Probst* teaches a multitude of parts for its 'nozzle arrangement' ((1),(2)), *Cicchetti* teaches a fewer number of parts to accomplish the same if not similar arrangement." See, Examiner's Answer, page 8, lines 10-13. Appellants respectfully submit that this statement implicitly admits that *Cicchetti* fails to remedy the deficiencies of *Probst*. For example, simply because *Cicchetti* teaches a "fewer number of parts" to accomplish a similar arrangement to the nozzle of *Probst*, this does not mean that *Cicchetti* teaches a nozzle configured in one piece as is required, in part, by the present claims. Appellants submit that the combination of cited references must disclose each and every element of the present claims for a *prima facie* case of obviousness to be found. This cannot be the case where the Examiner admits that *Probst* teaches "a multitude of parts" for its nozzle arrangement and *Cicchetti* teaches "a number of parts" to accomplish a device similar to that of *Probst*.

In contrast, *Cicchetti* is entirely directed to a steam heating device having several separate and disconnectable parts. See, *Cicchetti*, column 1, lines 57-67; column 2, lines 1-7 and 14-40. *Cicchetti* expressly states that "as clearly viewed from the figures, the described device can be easily disassembled should a thorough cleaning be required." See, *Cicchetti*, column 2, lines 51-53. *Cicchetti* further teaches that its steam heating device 10 includes a dispenser 27 axially disposed within a duct 25. See, *Cicchetti*, column 2, lines 14-17. The "duct 25 and dispenser 27 are axially slidable relative to each other." See, *Cicchetti*, column 2, lines 23-24. These

passages clearly show that the duct 25 and dispenser 27 are separate parts and cannot be formed as a single piece. In addition, *Cicchetti* discloses that “the valve unit 19 together with the starting portion of duct 17 [] can be bayonet-disconnected from body 29.” See, *Cicchetti*, column 2, lines 37-39. As such, Appellants respectfully submit that *Cicchetti* is entirely directed to a steam heating device including several disconnectable parts and fails to disclose a nozzle configured in one piece as required, in part, by the present claims. Accordingly, the cited references fail to disclose or suggest each and every element of the present claims.

Further, in the Examiner’s Answer, the Examiner states that “it has been upheld in the courts that forming what was previously a multitude of components into an integral one-piece structure is an extension of engineering logic and obvious to one having ordinary skill in the art.” See, Examiner’s Answer, page 8, lines 4-7. The Examiner also states that “it can only be of an extension of reasonable logic to extend this thinking to a one-piece disposable nozzle.” See, Examiner’s Answer, page 8, lines 14-15. However, the Examiner fails to identify any legal precedent that has been “upheld in the courts.” Further, Appellants respectfully submit that, even if it were true that such a modification were obvious to the skilled artisan at the time of the invention and in view of the prior art, which Appellants submit is not the case, it is well established that such a finding may be rebutted by Appellants.

For example, the Manual of Patent Examining Procedures (“MPEP”) states that “[i]f a *prima facie* case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case.” See, MPEP Section 2145 (quoting *In re Dillon*, 919 F.2d 688, 692, (Fed. Cir. 1990)). Initially, Appellants submit that the Examiner has failed to even establish a *prima facie* case of obviousness because the cited references fail to disclose or suggest each and every element of the present claims and the skilled artisan would have no reason to combine the cited references to arrive at the present claims. However, assuming that the Examiner has established a *prima facie* case of obviousness, Appellants have rebutted same.

For example, the MPEP also states that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).” See, MPEP, Section 2141.02. For example, *Probst* specifically states that “for better cleaning, but also for the uncomplicated production of the

emulsifying chamber and the adjacent regions, the emulsifying chamber has individual elements.” See, *Probst*, column 3, lines 43-46. *Probst* goes further to state that “[f]or cleaning purposes, the element 2 and the additional element 18 are detachably held together by a sleeve 19.” See, *Probst*, column 4, lines 57-67. Similarly, *Cicchetti* teaches disassembling the multiple individual components of its device for thorough cleaning. See, *Cicchetti*, column 2, lines 51-56; Fig. 1. By using multiple parts, prior art nozzles such as *Probst* and *Cicchetti* include regions where milk can be deposited and thus lead to bacterial contamination. See, specification, page 3, lines 1-9. The individual parts must therefore be disassembled in order to clean the nozzle, as clearly taught by *Cicchetti*. See, specification, page 1, lines 5-16. As such, the references, when considered as a whole, clearly teach away from using a nozzle configured in one piece as required, in part, by the present claims.

The MPEP goes even further to define what is not considered a sufficient “teaching away” argument by stating that “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” See, MPEP, Section 2141.02 (quoting *In re Fulton*, 391 F.3d 1195, 1201, (Fed. Cir. 2004)). Based on the criticism and discouragements clearly espoused in the disclosures of both *Probst* and *Cicchetti* when referring to the difficulty of cleaning devices that cannot be taken apart, Appellants respectfully submit that it is clear that both *Probst* and *Cicchetti* teach away from the present claims. Accordingly, Appellants also respectfully submit that, even if the Examiner has established a *prima facie* case of obviousness, the obviousness has been rebutted by Appellants.

Regarding the requirement of the present claims that the nozzle be plastic and “disposable,” the Examiner asserts that “any further process to make a piece disposable is an extension of common sense, as just about every manufactured good has a lifespan that requires eventual disposal or recycling.” See, Examiner’s Answer, page 8, line 22-page 9, line 2. Appellants submit that this is a tortured interpretation of the present requirement of disposability. Indeed, the specification is replete with portions indicating that the “disposability” of the nozzle is not merely discarding the nozzle at the end of a lifespan of the overall device, but rather the ability to dispose a used nozzle and replace it with a new nozzle. For example, the specification specifically states that the device “is disposable, at least after one day of use.” See, specification, page 1, lines 17-21. The specification further states that “[t]he benefit of this system is that it is

simple and therefore inexpensive, which makes it possible to use it for the day and then dispose of it after it has been used a few times, replacing it with a new nozzle the next day.” See, specification, page 2, lines 11-14. It is also disclosed that the presently claimed devices would “make it possible to use said nozzle for a day without any risk of bacterial contamination.” See, specification, page 3, lines 1-9. The specification further discloses that the nozzle “can therefore be disposed of once it has been used a few times through the day.” See, specification, page 5, lines 13-16. As such, Appellants respectfully submit that it is clear that the Examiner’s interpretation of “disposable” is in direct contrast to the definition of disposable as used by Appellants.

Further, Appellants submit that, although limitations from the specification cannot be read into the claims, the Federal Circuit has acknowledged, time and again, that the specification is the best source for understanding claim language and must be considered when viewing the claims. In fact, to properly interpret claim language, the Federal Circuit has held that claims must be read in view of the specification, of which they are a part. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995). Moreover, intrinsic evidence in the form of the patent specification should guide claim construction. Along these lines, the Federal Circuit reinforced the importance of the specification when interpreting claim language:

The claims, of course, do not stand alone. Rather, they are part of “a fully integrated written instrument,” *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims “must be read in view of the specification, of which they are a part.” *Id.* at 979. As we stated in *Vitronics*, the specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; *it is the single best guide to the meaning of a disputed term.*” 90 F.3d at 1582.

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005) (emphasis added).

Therefore, the specification remains the “single best guide” to interpreting the terms “disposable,” as used by Appellants in the specification and claims. Based on the consistent usage of the term “disposable” in the specification, Appellants submit that the term cannot be interpreted as discarding the nozzle as the end of the device lifespan, as is suggested by the Examiner. Instead, the “disposable” nozzle of the present claims is clearly meant to be used for a predetermined amount of time before being disposed of and replaced by a new nozzle.

For the reasons discussed above, Appellants respectfully submit that Claims 1 and 3-12 are novel, nonobvious and distinguishable from the cited reference.

Accordingly, Appellants respectfully request that the rejection of Claims 1 and 3-12 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the final Office Action. Therefore, Appellants respectfully request that the Board of Appeals reverse the obviousness rejections with respect to Claims 1 and 3-12.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00625 on the account statement.

Respectfully submitted,

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